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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/753,609	01/08/2004	Aurelie Joseph	A34635-PCT-USA-A-I 070337	6339

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EXAMINER	
CROUSE, BRETT ALAN	
ART UNIT	**PAPER NUMBER**
1774	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/753,609	JOSEPH ET AL.	
	Examiner	Art Unit	
	Brett A. Crouse	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 October 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *5-13* is/are pending in the application.

4a) Of the above claim(s) *7-13* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *5 and 6* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 09/969,753.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *20040801*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Miscellaneous

Upon review of the present claims it is the examiner's position that further restriction should be required. A revised restriction requirement is included below. Applicant's remarks as part of applicant's reply dated 16 October 2006, to the restriction requirement dated 22 August 2006 have been considered. As the revised restriction includes only claims 5 and 6 in Group II and per applicant's remarks of 16 October 2006, the election is also revised to encompass only claims 5 and 6 directed to a method of making an adhesive composition. This office action considers claims 5 and 6 only.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claim 7, drawn to textile fibers coated with an adhesive composition, classified in class 427, subclass 212.

II. Claims 5 and 6, drawn to a method of making an adhesive composition, classified in class 156, subclass 325.

III. Claims 8 and 9, drawn to a composite, classified in class 523, subclass 149.

IV. Claims 10-13, drawn to a tire body, classified in class 152, subclass 458.

The inventions are distinct, each from the other because of the following reasons:

Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions:

Group I and Group II are distinct because Group I relates to textile fibers coated with an adhesive composition and Group II relates to a method of making an adhesive composition, which are unrelated.

Group I and Group IV are distinct because Group I relates to textile fibers coated with an adhesive composition and Group IV relates to a tire body, which are unrelated.

Group II and Group III are distinct because Group II relates to an adhesive composition and Group III relates to a composite material, which are unrelated.

Group II and Group IV are distinct because Group II relates to an adhesive composition and Group IV relates to a tire body, which are unrelated.

Group III and Group IV are distinct because Group III relates to a composite and Group IV relates to a tire body, which are unrelated.

Inventions I and III are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product, and the species are patentably distinct (MPEP § 806.05(j)). In the instant case, the intermediate product is deemed to be useful as a calendarable sheet material and the inventions are deemed

patentably distinct because there is nothing on this record to show them to be obvious variants.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over (Caldwell et al., US 2,976,182) hereinafter known as Caldwell.

Caldwell teaches in column 2, lines 62-72, an elastomeric waterproof film comprising butadiene polymers. Caldwell further teaches in column 3, lines 18-20 that water can be used to form a suspension of the elastomer. Caldwell further teaches in column 3, lines 30-43, that an organic pigment can be suspended in water and added to the elastomeric suspension. Caldwell further teaches in column 3, lines 48-50 that thermosetting phenolic resins can additionally be added. Caldwell further teaches in example 6, column 5, line 66 through column 6, line 14 the preparation of an aqueous composition by forming a water suspension of organic pigment and the addition thereto of a butadiene copolymer with mixing. Example 6 teaches 30 grams of pigment in 100 grams of water prior to mixing with the latex-butadiene suspension. The resulting combined suspension of example 6 contains the pigment in approximately 11 mass percent. Caldwell in example 9, column 6, lines 54-63, provides masses of components of the composition, but, does not teach specific volumes of water other than the example is prepared by the method of example 6. Caldwell does not provide an

example in support of the generic teachings that the pigment and butadiene elastomer are both suspended in water prior to mixing. Caldwell further does not teach a specific range of the mass percent of pigment in the aqueous dispersion, rather teaching a 5 to 60 mass percent range of the resulting film. It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to prepare aqueous dispersion of organic pigment and aqueous suspension of butadiene elastomer prior to mixing based on the teachings of Caldwell to control the viscosity of the aqueous mediums before and after mixing. Further it would have been obvious to one of ordinary skill in the art to optimally select a mass fraction of pigment in aqueous suspension to control the viscosity of the suspension.

Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over (Hopkins, US 2,875,166) hereinafter known as Hopkins.

Hopkins teaches in column 1, lines 14-15 that the purpose of his invention is to provide compositions and methods to thicken aqueous dispersions. Hopkins further teaches in column 4, lines 39-51, that thickening compositions can be applied to dispersions of elastomeric substances such as polymers and copolymers of dienes such as butadiene. The passage further teaches the use of thermosetting phenolic resins. Hopkins further teaches in column 4, lines 23-31, that pigments can be added to the dispersion and that the timing of the addition before or after adding other ingredients is not restricted. The passage further teaches that the concentration of pigments is not restricted in order for one skilled in the art to create desired effects. Hopkins teaches

only clay (inorganic) pigments. Further, Hopkins does not provide an explicit example of the mixing of pigments and dienes, rather relying on generic teachings of mixing such as noted above. It would have been obvious to one of ordinary skill in the art to prepare and mix aqueous mixtures of dienes and pigments to form an aqueous dispersion comprising the compounds of the instant invention based on the compositions taught as the dispersions of Hopkins. Further, it would have been obvious to one of ordinary skill in the art to optimally select pigments and pigment concentrations to create the desired visual effects.

Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over (JP 60139876, Iizuka et al.) (English Abstract), hereinafter known as Iizuka.

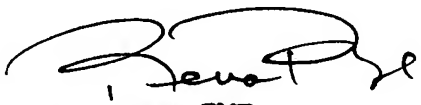
Iizuka teaches in the abstract a processing solution comprising butadiene, resorcinol, water, and pigment. The pigment is present in the amount of 2 percent to 10 percent. The Iizuka abstract does not recite the process of mixing. Further, the Iizuka abstract does not specify an organic pigment. It would have been obvious to one of ordinary skill in the art that a solution of the materials involves a mixture of the materials (i.e. mixing the materials). It would have been obvious to one of ordinary skill in the art to select an appropriate water soluble pigment, such as an organic pigment, in order to produce a processable solution having the desired visual properties.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brett A. Crouse whose telephone number is 571-272-6494. The examiner can normally be reached on Monday - Friday 6:00AM - 2:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BAC 5 January 2007



RENA DYE
SUPERVISORY PATENT EXAMINER
Art Unit 1774